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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,782

09/30/2003

James Mac Freitag

HSJ9-2003-0071US2
(0107-0)

6536

7590

03/16/2006

EXAMINER

HEINZ, ALLEN J

ATTN: John J. Oskorep
One Magnificent Mile Center
Suite 1400
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Chicago, IL 60611

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,782

Applicant(s)

FREITAG ET AL.

Examiner

A. J. HEINZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Applicant's election, with traverse, of the Group II invention[Cls.1-22] in Paper dated 21 February 2006 is acknowledged.

The traversal is on the ground(s) that the examiner has misinterpreted the limitations of the process claims

This is not found to be persuasive even though the applicant is correct with regard to some of the aspects of the method claims; such as the chronological order of the claimed steps, however examiner's instant evaluation of the claims is that the process claims are historically and technically of a distinctly different statutory category of invention and would require instinctively different evaluational procedures from those of the apparatus, e.g. does the specification also adequately support and/or enable the process.

Should applicant wish to make of record his or her confidence that the process claims present no different invention than those of the apparatus, then applicant should so state on the record that all claims (whether process or apparatus) shall stand or fall together (patentably).

The requirement is still deemed proper and is therefore made FINAL.

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Claims 23-30 are withdrawn from further consideration by the examiner, pursuant 37 CFR 1.142(b), as being drawn to the non-elected invention.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of Cls.9&20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1,4-8,12,15-19 are rejected under 35 U.S.C. §102() as being clearly anticipated by applicant's disclosed prior art in figure 10.

5. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 2,3,9-11,13,14,20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over applicant's disclosed prior art in figure 10 as applied to claim 1 above, and further in view of Fukuzawa or Yuasa.

Applicant's disclosed prior art in figure 10 does not disclose the specific cobalt composition of the pinned layers.

Fukuzawa and Yuasa both document the use of pure cobalt for the pinned layers in a magnetoresistive devices. See for example Fukuzawa: col. 30, lines 65-67; or Yuasa: col.12, lines 20-24.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate one of the pinned layers of pure cobalt in view of Fukuzawa or Yuasa.

Rationale: the use of pure cobalt is simply an alternative material for achieving the same results for the same purposes as the know cobalt-iron formulations.

7. For a complete response applicant should identify how the claimed structure of his invention defines over **all** the art of record.

Moreover, where the applicant disagrees with the reasoning and/or application of the prior art on critical points of the claims, they should identify how the claimed structure of their invention defines over **all** the art of record not just the applied art.

Where applicant believes that the art is redundant and/or superfluous relative to the critical aspects of the claimed invention the applicant may simply state so in rebuttal summary.

8. If applicant has filed an information disclosure statement and this instant office action does not contain an initialed-off copy (or copies) of all such filed IDS's (or at least a comment

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to the disposition of such IDS'S in the body of the office action itself) applicant should apprise the examiner of such missing documentation [to the IDS's] in response to this office action so that the examiner can take appropriate action to supply same to the applicant.

Note; the application papers were accompanied by several non-patent literature documents but did not include any 1449 form.

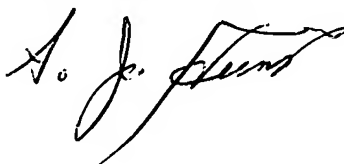
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. J. HEINZ whose telephone number is (571) 272-7587. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DWAYNE BOST can be reached on (571)272-7023.

The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. J. HEINZ
Primary Examiner
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A handwritten signature in black ink, appearing to read 'A. J. Heinz', is written over the printed name and title.